

REMARKS

This amendment and request for withdrawal of a Restriction Requirement under 37 C.F.R. 1.143 is in response to a Restriction Requirement (Paper No. 9) mailed 8 July 2003. Upon entry of this amendment, claims 1, 2, 4-8 and 16-32 will be pending in this application. Applicant has newly added claims 31 and 32 by this amendment.

In Paper No. 9, the Examiner restricted Applicant's invention as follows:

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Group I, Claims 1-11 and 12-24 drawn to a peripheral configuration of portable memory device, classified in class 710, subclass 8;

Group II, claims 12-15, drawn to the method of peripheral adapting, classified in class 710, subclass 62; and

Group III, claims 16-20 and 25-30, drawn to the method of input/output access regulation, classified in class 710, subclass 36.

Also in Paper No. 9, the Examiner restricted Applicant's invention to the following species:

Specie 1, Figs. 1A-1B, directed to a memory device with a hole;

Specie 2, Figs. 2A-2C, directed to the cover of the memory device;

Specie 3, Figs. 3, 4A and 4B, directed to the connection between a USB memory device and a USB supporting computer;

Specie 4, Fig. 5, directed to the circuit configuration of a USB memory device;

Specie 5, Fig. 6, directed to the operation steps of a USB memory device used as a portable

memory medium; and

Specie 6, Fig. 7, directed to the operation steps of a USB memory device used as a security key.

In Paper No. 9, the Examiner required Applicant to elect a single group **and** a single specie or else the Examiner would deem Applicant's response as non-responsive.

Applicant hereby provisionally elects Group III and Specie 6 with traverse.

1. Applicant hereby traverses the restriction requirement for the following reasons:

A. Error regarding Group II

In Paper No. 9, the Examiner indicated that Group II contained claims 12-15. However, in the amendment filed on May 19, 2003, claims 12-15 were canceled. Therefore, Applicant submits that the above restriction requirement is defective.

B. Restriction requirement is inconsistent and discriminatory vis-a-vis Sartore '103

In the above restriction requirement, Group I claims are apparatus claims pertaining to the structure of the USB memory stick and Group III claims are method claims pertaining to a method using the USB memory stick. In Paper No. 5, the Examiner applied Sartore *et al.*, U.S. Patent No.

6,012,103 to reject Applicant's claims. It is kindly noted that claim 1 of Sartore '103 is an apparatus claim of a system comprising a host computer and a peripheral device, claim 14 is a method claim claiming a method of configuring the host computer and peripheral device and claim 24 is an apparatus claim for the peripheral interface. The fact that all three of these different types of claims are in a single issued U.S. Patent applied by the Examiner is evidence that the method and the different apparatus claims were not restricted in Sartore '103 as the Examiner is now trying to do to Applicant in Paper No. 9. Since patents are presumed valid, and since Sartore '103 has both method and apparatus claims, Applicant submits that the imposition of the present restriction requirement of Paper No. 9 on Applicant's claims is both inconsistent and discriminatory. Therefore, Applicant requests withdrawal of the above restriction requirement.

C. No need for separate classification

In Paper No. 9, the Examiner classified Group I claims to class 710, subclass 8. Class 710 is Electrical computers & digital data processing systems: input/output and subclass 8 is peripheral configuration: **means or steps** for assigning operating characteristics to a peripheral. Group III was classified in class 710, subclass 36. Subclass 36 is I/O access regulation: **means or steps** for controlling which of the peripherals may transfer data with which of the digital data processing systems or computers. Applicant submits that since each subclass is described as "**means or steps**", this indicates that each of subclass 8 and 36 pertains to both method **and** apparatus. Because each of subclass 8 and 36 in class 710 pertains to both apparatus and method, Applicant submits that the Group I claims and the Group III claims do not necessarily need to fall in separate classifications.

Because the Group I and the Group III claims do not fall into different classifications, there is no undue burden on the part of the Examiner to examine Group I and Group III claims in a single examination. Because there is no undue burden, the restriction requirement of Paper No. 9 must be withdrawn.

D. Examiner misclassified Group I and Group III claims in Paper No. 9

Applicant further submits that Group I and Group III claims were misclassified by the Examiner in Paper No. 9. Applicant submits that Applicant's USB memory stick does not assign operating characteristics to a peripheral as subclass 8 of class 710 requires. Applicant also submits that the security method is not controlling which peripherals may transfer data with which computers as subclass 36 of class 710 requires. Instead, the Group III claims deny access to the entire computer and the USB memory stick if the passwords do not match. These claims in Group III therefore do not fall within the description of subclasses 8 and 36 of class 710. Because the Examiner did not correctly classify Applicant's pending claims in Paper No. 9, the Examiner failed to show undue burden necessary to justify a restriction requirement. Therefore, the restriction requirement in Paper No. 9 must be withdrawn.

2. Traversal of the Election of Species requirement

A. Paper No. 9 fails to comply with 37 C.F.R. 1.146

37 C.F.R. 1.146 mandates that an Election of Species requirement be made **in the first**

action on an application. Applicant submits that the election of species requirement of Paper No. 9 comes after an action on the merits (Paper No. 5 mailed February 27, 2003). Because Paper No. 9 contains an election of species requirement, and because Paper No. 9 is not the first office action for this instant patent application, Applicant submits that the Examiner did not abide by 37 C.F.R. 1.146 by issuing Paper No. 9. Therefore, the election of species requirement of Paper No. 9 must be withdrawn.

B. Paper No. 9 fails to comply with 37 C.F.R. 1.146

37 C.F.R. 1.146 states that the examiner “may require restriction of the claims **to not more than a reasonable number of species**”. Applicant submits that the six species listed in Paper No. 9, together with the three groups, is an unreasonable number of species. Therefore, the election of species requirement of Paper No. 9 is obstructionistic, an abuse of power on the part of the Examiner, and does not comport with notions of compact prosecution.

C. Paper No. 9 fails to comply with MPEP 806.03

MPEP 806.03 forbids restriction or election of species where a single embodiment is disclosed. In Paper No. 9, the Examiner is separating the cover feature, the interface feature and the circuit configuration of the apparatus of the USB memory stick into different species. Applicant submits that the presence or absence of these features in a particular claim is not indicative of separate embodiments. Instead, the presence or absence of these features in certain claims is evidence of varying scope of the claims. Since requiring claims of varying scope describing a single

embodiment to be split up into different patent applications is forbidden by MPEP 806.03, the election of species requirement of Paper No. 9 must be withdrawn.

D. Paper No. 9 fails to comply with MPEP 806.04 (f)

MPEP 806.04 (f) requires that if claims are restricted to different species as was done in Paper No. 9, claims that claim one specie must not also claim another specie. Also, claims that claim the other specie must not claim the first specie (mutual exclusion). Applicant submits that Applicant's claims are not mutually exclusive and therefore should not be subject to an election of species requirement. For example, claim 1 claims the cover which is specie 2 in addition to the USB interface (Specie 4) and depending claim 8 claims steps S36-S40 of FIG. 7 (specie 6). Because the features of species 2, 4 and 6 are in a single claim (claim 8 for example), the features of species 2, 4 and 6 are not mutually exclusive. Therefore, MPEP 806.04 (f) was not abided to in the election of species requirement of Paper No. 9. Therefore, the election of species requirement of Paper No. 9 is improper and must be withdrawn.

E. 37 C.F.R. 1.141 (a)

37 C.F.R. 1.141 (a) allows more than a single specie to be claimed in a single patent application. Therefore, the election of species requirement in Paper No. 9 is unnecessary.

3. Conclusion

Therefore, Applicant requests the withdrawal of the restriction requirement and the election

of species requirement of Paper No. 9.

Applicant has also newly added linking claims 31 and 32 by this amendment. These linking claims serve to overcome the restriction between Group I and Group III.

A fee of \$36 is incurred by the addition of two (2) additional claims in excess of 20. Applicant's check drawn to the order of Commissioner accompanies this Response. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

A fee of \$110.00 is incurred by filing of a petition for a one month extension of time, set to expire on September 8, 2003. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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